

## **REMARKS:**

Claims 1-5, 9, 10, and 12-25 are currently pending in the present Application. Claims 5, 9, and 12 are hereby cancelled.

Claims 1-5, 9, 10, and 12-25 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-6 of co-pending Application 11/072,382 (the "'382 application"). Claims 1-5, 9, 10, and 12-25 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-25 of co-pending Application 10/523,942 (the "'942 application").

Claims 1, 9, 10, 12, 13, 15, 20, and 21 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,117,526 to Marks ("*Marks*"). Claims 2-5, 14, 16-19, and 22-25 stand rejected under 35 USC § 103(a), as being unpatentable over *Marks* in view of WO 00/08622 to Neal ("*Neal*").

## **Provisional Double Patenting Rejections:**

Claims 1-25 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-6 of the '382 application. In addition, Claims 1-25 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-25 of the '942 application.

Applicant notes these provisional rejections, which will be taken up in due course upon allowance of either the '382 application or the '942 application.

## **Rejections Under 35 U.S.C. § 102(b):**

Claims 1, 9, 10, 12, 13, 15, 20, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Marks*. The Applicant respectfully traverses the rejections for at least the reasons set forth below.

With respect to independent Claims 1 and 20, the Examiner states that *Marks* discloses the claimed skin for use with a handheld electronic device. Claims 1 and 20 are hereby amended to more particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. In particular, Claims 1 and 20 are hereby amended to include the following features: (1) an anti-slip layer adhered over the decorative layer, the anti-slip layer having a soft pliable non-abrasive surface finish having a high coefficient of friction so as to restrict movement of the handheld electronic device relative to a hard non-pliable contact surface; and, (2) a plurality of uniformly sized rounded dimples integral with the surface of the anti-slip layer. The Applicant respectfully disagrees that *Marks* discloses or teaches Claims 1 and 20, as amended.

With respect to feature (1), *Marks* fails to disclose or teach an anti-slip layer having a soft pliable non-abrasive surface for contact with a hard non-pliable contact surface. In fact, *Marks* teaches away from these features.

*Marks* discloses a skin for attaching to a portable computer, which provides added gripping means between the user's hand and the hard surface of the computer. See Abstract and Figure 3. The *Marks* skin comprises a high friction top surface and an adhesive bottom surface. The high friction top surface utilizes 3M's Safety-Walk™ General Purpose Antislip tape, which can be either coarse, medium, or fine grades. See column 5, lines 11-49. It should be noted that the *Marks* top surface is composed of material that creates a hard, non-pliable surface, i.e., abrasive mineral particles bonded by a tough, durable polymer. See Column 5, lines 18-20.

The *Marks* anti-slip surface does not have a high coefficient of friction in and of itself. With the *Marks* tape, friction is generated when a soft contact surface, such as human flesh or the sole of a shoe, is pressed into the hard upraised bumps and ridges formed by the hard abrasive particles. *Marks* discloses a skin that generates friction by the mechanical compression engagement between hard particles on a strip and soft human flesh, not the inherent surface characteristics of the material. The *Marks* product is only slip resistant because of its texture, height, and gaps between strips. Because the *Marks* tape consists of hard, abrasive particles, it is not a thin, soft pliable skin. The

*Marks* material would be more susceptible to scratching a contact surface. The *Marks* skin does not work to keep the abrasive tape from slipping on a hard smooth surface, such as a glass table top or car dashboard. This type of roughly textured surface is precisely what the claimed skin seeks to avoid.

On the other hand, Claims 1 and 20, as amended, are directed to a soft, pliable anti-slip skin that utilizes for contact with a hard, non-pliable surface. The high coefficient of friction in the claimed skin is inherent in the surface finish of the anti-slip layer. As such, the claimed skin does not rely upon mechanical compressive force to generate friction, nor does the claimed skin bind with a user's flesh. See Figure 3 and column 6, lines 17-18 of *Marks*. The *Marks* tape could not bind to a user's flesh if it had a soft pliable surface like the claimed skin. The surface finish of the anti-slip layer in the claimed skin produces the high coefficient of friction, which in turn prevents slipping when the hand held device is placed on a hard surface.

With respect to feature (2), the Applicant submits the *Marks* fails to disclose or teach a plurality of uniformly sized rounded dimples integral with the surface of the anti-slip layer. *Mark* teaches away from these features.

As discussed above, *Marks* merely discloses a tape having a hard, non-pliable surface for adding gripping support between a laptop and the hand of a user. The top surface comprises 3M's Safety-Walk™ General Purpose Antislip tape, or the like, which can be either coarse, medium, or fine grades. See column 5, lines 11-49. The top surface is composed of a material that forms a hard, non-pliable surface, i.e., from abrasive mineral particles bonded by a tough, durable polymer. Essentially, *Marks* top surface is sand paper, wherein the abrasive materials are bonded within a polymer.

On the other hand, Claims 1 and 20, as amended, are directed to uniformly sized rounded dimples being integral with the surface of the anti-slip layer. The soft, pliable anti-slip surface with dimples provides efficient means for securing the portable electronic device, i.e., a cell phone, to a non-pliable hard contact surface such as a

dashboard of a car. *Marks* fails to disclose, teach, mention or suggest a plurality of dimples integral with the anti-slip surface.

For at least these reasons, the Applicant submits that *Marks* fails to anticipate Claims 1 and 20, as amended. The Applicant submits that foregoing amendments and remarks with regard to Claims 1 and 20 overcome the Examiner's rejections under 35 U.S.C. § 102(b) and that Claim 1 and 20 are now in condition for allowance. Therefore, the Applicant respectfully requests that Claims 1 and 20, as amended, be allowed.

Claims 9 and 12 are hereby cancelled for consistency with Claim 1. Thus, the Examiner's rejections to Claims 9 and 12 under 35 U.S.C. § 102(b) are moot.

Claims 10, 13, 15, 20, and 21 are dependent claims dependent on Claims 1 and 20. The Applicant submits that foregoing amendments and remarks with regard to Claims 1 and 20 overcome the Examiner's rejections under 35 U.S.C. § 102(b) and that Claim 1 and 20 are now in condition for allowance. Because Claims 10, 13, 15, 20, and 21 are dependent upon and further limit Claims 1 and 20, the Applicant submits that Claims 10, 13, 15, 20, and 21 are also in condition for allowance. Therefore, the Applicant respectfully requests that Claims 10, 13, 15, 20, and 21 be allowed.

**Rejections Under 35 U.S.C. § 103(a):**

Claims 2-5, 14, 16-19, and 22-25 stand rejected under 35 USC § 103(a), as being unpatentable over *Marks* in view of *Neal*. Claim 5 is hereby cancelled for consistency with Claim 1. Thus, the Examiner's rejections to Claim 5 under 35 U.S.C. § 102(b) are moot. The Applicant respectfully traverses the rejections to Claims 2-4, 14, 16-19, and 22-25 for at least the reasons set forth below.

With respect to Claims 2-4, 14, 16-19, and 22-25, the Examiner states that *Marks* discloses the features of the skin found in Claims 1 and 20, but fails to disclose the limiting features found in Claims 2-4, 14, 16-19, and 22-25, namely, the thicknesses of the layers and the presence of a decorative layer. The Examiner relies on *Neal* to teach

these features and states that it would have been obvious to combine the teachings of *Neal* with *Marks* to arrive at the claimed invention. The Applicant respectfully disagrees.

*Neal* discloses an improved label for placement on a substrate, i.e., a package for delivery. Figure 1 of *Neal* illustrates label 1 comprising a thermoplastic layer 4 for covering a printed layer 6. Layer 4 and decorative layer (any of 4-7) can be of a thickness of less than 0.5mm. See page 8, lines 7-9 and page 10, lines 6-10.

The Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teachings of *Marks* to form the anti-slip layer and decorative layer of a thickness of less than 0.5mm, as is disclosed in *Neal*, since those are known thicknesses for those layers.

It should be noted that the *Neal* label is not intended to be used as a skin for providing gripping means. *Neal* has nothing to do with anti-slip appliqués. Top surface layer 4 is a coextruded sheet of a thermoplastic elastomer and a polyolefin. *Neal* merely discloses a label overlaid with plastic. The plastic itself generates a soft feel. *Neal* makes no mention whatsoever of providing an anti-slip layer having a surface finish having a high coefficient of friction.

Claims 2-4, 14, 16-19, and 22-25 are dependent claims dependent on Claims 1 and 20. The Applicant reiterates here all of the distinguishing comments set forth above with respect to Claims 1 and 20. In particular, *Marks* fails to disclose or teach an anti-slip layer having a soft pliable non-abrasive surface for contact with a hard non-pliable contact surface. In addition, *Marks* fails to disclose or teach a plurality of uniformly sized rounded dimples integral with the surface of the anti-slip layer. These features are not disclosed, taught, mentioned, or suggested by *Marks*. Because Claim 2-4, 14, 16-19, and 22-25 are dependent upon and further limits Claims 1 and 20, the Applicant submits that Claim 2-4, 14, 16-19, and 22-25 are also in condition for allowance. Therefore, the Applicant respectfully requests that Claim 2-4, 14, 16-19, and 22-25 be allowed.

With further respect to Claims 18, 19, 24, and 25, the Examiner merely states "see page 3, line 21 through page 7, line 36 for the thermoplastic rubber used for the

anti-slip layer." *Neal* does not teach, mention, or disclose providing an anti-slip layer having a surface finish having a high coefficient of friction to restrict movement of a hand held electronic device relative to a contact surface. *Neal* label is not intended to be used as a skin for providing gripping means. *Neal* has nothing to do with anti-slip appliqués. *Neal* merely discloses a label overlaid with plastic.

With further respect to Claims 17 and 23, the Examiner states that to substitute silicone resin for the elastomer as taught by *Neal* would be obvious to one of ordinary skill in the art since this would merely involve substituting one anti-slip material for another one. Neither *Marks* nor *Neal* teach, mention, suggest, or otherwise disclose the use of a liquid silicone rubber to form the anti-slip layer having a high coefficient of friction. The unique combination of materials gives the claimed skin its unique characteristics, including its high coefficient of friction, and its ability to prevent hand held devices from slipping. The references cited by the Examiner simply do not disclose these features.

Thus, the Examiner has provided no teaching, suggestion, or motivation in the prior art that would have lead one of ordinary skill in the art to modify either *Marks* or *Neal* to arrive at the claimed invention. Rather, the Applicant respectfully submits that any attempt to assert that either *Marks* or *Neal* discloses or suggests the claimed invention as a whole is necessarily based on an improper use of hindsight using Applicant's disclosure as a roadmap.

For at least these reasons, the Applicant submits that the claimed skin is not unpatentable over *Marks* in view of *Neal*. Therefore, the Applicant respectfully requests that Claims 2-4, 14, 16-19, and 22-25 be allowed.

For at least these reasons, the Applicant submits that Claims 2-4, 14, 16-19, and 22-25 are not rendered obvious over *Marks* in view of *Neal*. The Applicant submits that foregoing remarks with regard to Claims 2-4, 14, 16-19, and 22-25 overcome the Examiner's rejections under 35 U.S.C. § 103(a) and that Claims 2-4, 14, 16-19, and 22-

25 in condition for allowance. Therefore, the Applicant respectfully requests that Claims 2-4, 14, 16-19, and 22-25 be allowed.

**Distinctions, Other Than Those Discussed, May Exist:**

It should be noted that the Applicant has merely discussed example distinctions from the various references cited by the Examiner. Other distinctions may exist and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal. By not responding to the additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The remarks provided above are sufficient to overcome the Examiner's rejections.

## CONCLUSION:

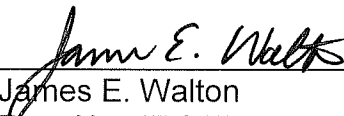
The Applicant submits that the foregoing amendments and remarks made with respect to Claims 1-4, 10, and 13-25 traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a), and that Claims 1-4, 10, and 13-25 are now in condition for allowance. Therefore, the Applicant respectfully requests that Claims 1-4, 10, and 13-25, as amended, be allowed.

The Applicant submits that the subject application is now considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 447-9955 with any questions, comments, or suggestions relating to the referenced patent application.

This Amendment Under 37 C.F.R. § 1.114 is being filed via the U.S. Patent and Trademark Office's EFS-Web electronic filing system. No fees are deemed to be necessary; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Respectfully submitted,

5/18/10  
Date

  
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